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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/715,215
Filing Date: November 18, 2003
Appellant(s): KUCHAROWSKI ET AL.

Andrew T. Foy
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/5/2008 appealing from the Office action mailed 8/20/2007.

(1) Real Part in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

Examiner has clarified the rejection to clarify the rejection as applicant has stated in his arguments.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2004/0003071

Mathew et al.

1-2004

**Courant, R. and Robbins, H. "The Algebra of Sets." Supplement to Ch. 2 in
What Is Mathematics?: An Elementary Approach to Ideas and Methods, 2nd ed.
Oxford, England: Oxford University Press, pp. 108-116, 1996**

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 12-16, 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bates (US 6247043).

For claim 1, a method for enabling management of contacts, the method comprising:

passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member; (Bates, Col. 15 lines 42-57, threshold)

identifying, to the, member the set of contacts that has been passively recognized as a set of contacts that are, as a group repeatedly sent communications by the member; (Bates, Col. 17 lines 10-20, group)

based on passively recognizing that the set of contacts are, as a group, repeatedly sent communication by the member, generating a contacts list that includes the set of contacts and that is useful in addressing future communications to the set of contacts as a group; (Bates, Col. 17 lines 10-20, group)

enabling the member to associate a name with the contact list; (Bates, Col. 8 lines 15-22, name)

and enabling the member to address future communications to the set of contacts, as a group, through use of the name associated by the member with the, contact list. (Bates, Col. 15 lines 42-57, threshold)

For claim 2, Bates teaches, the method of claim 1, wherein the passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member comprises:

storing communications sent by the member during a period of time; (Bates, Col. 15 lines 42-57, threshold)

examining the communications sent by the member during the period of time; (Bates, Col. 15 lines 42-57, threshold)

and identifying that the set of contacts was sent at least a minimum number of communications by the member during the period of time. (Bates, Col. 15 lines 42-57, threshold)

For claim 3, Bates teaches, the method claim 1 wherein the passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member comprises:

storing a predetermined number of communications sent by the member; (Bates, Col. 15 lines 42-57, threshold)

examining the predetermined number of communications sent by the member; (Bates, Col. 15 lines 42-57, threshold)

and identifying that the set of contacts was sent at least a minimum number of communications out of the predetermined number of communications by the member. (Bates, Col. 15 lines 42-57, threshold)

For claim 4, Bates teaches, the method of claim 1 further comprising enabling the member to accept or to reject contacts list. (Bates, Col. 10 line 60 to Col. 11 line 14, search)

For claim 5, Bates teaches, the method of claim 4 further comprising enabling the member to delay the generation of a rejected contact list. (Bates, Col. 10 line 60 to Col. 11 line 14, accepted, depress a key)

For claim 6, Bates teaches, the method of claim 1 further comprising enabling the member to assign a unique identifier to the contacts list. (Bates, Col. 8 lines 15-22, name)

For claim 7, Bates teaches, the method of claim 1 wherein enabling the member to address future communications to the set of contacts through use of the name associated by the member with the list of contacts through use of the name associated by the member with the list of contacts comprises enabling the member to address future communications to the set of contacts from multiple applications through the use of the name associated by the member with the list of contacts. (Bates, Col. 17 lines 10-20, group)

For claim 8, Bates teaches, the method of claim 7 wherein the multiple applications include communications applications. (Bates, Col. 13 lines 31-45, email)

For claim 9, Bates teaches, the method of claim 8 wherein the communications applications include an e-mail application and at least one application other than an e-mail application. (Bates, Col. 13 lines 31-45, email)

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For claim 11, Mathew teaches, the method of claim 8 wherein the communications application include a digital image sharing application and at least one application other than a digital image sharing application. (Mathew, Col. 16 lines 35-42, image)

For claim 12, Bates teaches, the method of claim 8, wherein the communications applications include an alerting application that sends alerts and reminders to users and at least one application other than an alerting application that sends alerts and reminders to users. (Bates, Col. 18 lines 20-27, alert)

For claim 13, Bates teaches, the method of claim 8 wherein the communications applications include an application for sharing and exchanging contact information and at least one application other than an application for sharing and exchanging contact information. (Bates, Col. 18 lines 35-67, messaging groups)

For claim 14, Bates teaches, the method of claim 7 wherein the multiple applications include other sharing applications. (Bates, Col. 16 lines 35-45, image)

For claim 15, Bates teaches, the method of claim 14 wherein the other sharing applications include an electronic calendar application and at least one application other than an electronic calendar application. (Bates, Col. 1 lines 45-55, calendar, Col. 7 lines 15-40, groupware)

For claim 16, Bates teaches, the method of claim 14 wherein the other sharing applications include an electronic journal application and at least one application other than an electronic journal application. (Bates, Col. 7 lines 15-40, groupware)

For claim 19, Bates teaches, an apparatus comprising a computer readable medium having instructions stored thereon that when executed by a machine result in at least the following:

passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member; (Bates, Col. 15 lines 42-57, threshold)

identifying, to the member, the set of contacts that has been passively recognized as a set of contacts that are, as a group, repeatedly sent communications by the member; (Bates, Col. 17 lines 10-20, group)

based on passively recognizing that the set of contacts are, as group, repeatedly sent communications by the member, generating a contact list that includes that set of contacts and that is useful in addressing future communications to the set of contacts as a group; (Bates, Col. 17 lines 10-20, group)

enabling the member to associate a name with the contacts list; (Bates, Col. 8 lines 15-22, name)

and enabling the member to address future communications to the set of contacts, as a group, through use of the name associated by the member with the contact list. (Bates, Col. 17 lines 10-20, group)

For claim 20, Bates teaches, a system of enabling management of contacts comprising:

means for passively recognizing that a set of contacts are, as a group, repeatedly sent communications by a member; (Bates, Col. 15 lines 42-57, threshold)

means for identifying, to the member, the set of contacts that has been passively recognized as a set of contacts that are, as a group, repeatedly sent communications by the member; (Bates, Col. 17 lines 10-20, group)

means for generating a contact list that includes the set of contacts based on passively recognizing that the set of contacts are, as a group, repeatedly sent communications by the member, the contacts list being useful in addressing future communications to the set of contacts as a group; (Bates, Col. 15 lines 42-57, threshold)

means for enabling the member to associate a name with the contact list; (Bates, Col. 17 lines 10-20, group)

and means for enabling the member to address future communications to the set of contacts, as a group, through the name associated by the member with the contacts list. Bates, Col. 8 lines 15-22, name)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-11 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bates in view of Mathew (US 2004/0003071).

For claim 10, Bates teaches, the method of claim 8 wherein the communications applications and at least one application other than an instant messaging application. (Bates, Col. 7 lines 15-40, groupware)

Bates fails to clearly disclose, instant messaging application

Mathew teaches, instant messaging application ((balh2), paragraph 44)

both Bates and Mathew are in the field of electronic communications

Bates and Mathew are compatible systems

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to add parental control and instant messaging to the system of Bates in order to provide protection for children (Mathew, paragraph 3)

For claim 17, Bates teaches, the method of claim 14 wherein the other sharing applications include an e-mail filter application and at least one application other than an e-mail filtering applications. (Bates, Col. 7 lines 15-40, groupware)

Bates fails to clearly disclose, e-mail filter

Mathew teaches, e-mail filter (Mathew, paragraph 44)

both Bates and Mathew are in the field of electronic communications

Bates and Mathew are compatible systems

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to add parental control and instant messaging to the system of Bates in order to provide protection for children (Mathew, paragraph 3)

For claim 18, Bates teaches, the method of claim 14 wherein the other sharing applications include an application that enables the specification and at least one application other than an application that enables the specification of parental controls over a child account. (Bates, Col. 7 lines 15-40, groupware)

Bates fails to clearly disclose, parental controls

Mathew teaches, parental controls (Mathew, paragraph 44)

both Bates and Mathew are in the field of electronic communications

Bates and Mathew are compatible systems

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to add parental control and instant messaging to the system of Bates in order to provide protection for children (Mathew, paragraph 3)

(10) Response to Argument

A) In response to appellant's arguments directed to the grounds of rejection, based upon appellants argument appellant was aware of the grounds of rejection and the rejection has been clarified to reflect the rejection as described by the appellant. It appears appellant is aware of the grounds of rejection and chosen argue the claims as a group addressing the feature of claim 1 and using that line of reasoning for the other independent claims 19 and 20. Therefore examiner was able to understand the rejection regardless of the typo in the rejection and was aware of the application of the prior art, based upon his arguments.

B) The appellant appear to make a singular argument directed to the prior art that the present invention fails to disclose "passively recognizing that a set of contacts are,

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as a group, repeatedly sent communications by a member.” Applicant clearly admits at the bottom of page 6 of the appeal brief that the prior art teaches these feature for a individual user. Also examiner in light of the specification being silent to the terms "a set of contacts" and "as a group" the examiner has interpreted these terms as broadly as possible in light of the specification and in terms of the art. Specifically a set in the art is a math mathematical term, which is understood to possible contain 0, 1 or a infinite amount of objects (see definition of a set). Therefore as appellant has admitted the prior anticipates this feature by teaching an individual user who is passively recognized as a group of on and a set of one. Bates passively recognizes a user by counting the number of communications and identifying the user and assign the group of used a user name as the identifier. Appellant has not presented any additional arguments, and therefore appellant has failed to distinguish over the prior art.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/A. B./

Examiner, Art Unit 2145

Conferees:

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145

/Rupal D. Dharia/

Supervisory Patent Examiner, Art Unit 2141